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EXAMINER

MYERS, PAUL R

ART UNIT PAPER NUMBER

2112

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,153

Applicant(s)

LUNSFORD ET AL.

Examiner

Paul R. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,30,31,34-37,39 and 42-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,30,31,34-37,39 and 42-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/22/05.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the double patenting rejections filed 7/21/05 have been fully considered but they are not persuasive.

The amendment to the claims has broadened the claim language. "Absent some indication of unexpected properties, the combination [A and B] renders B obvious" See *In re Emert* 124 F.3d 1458, 1459, 44 USPQ 2d 1149 (Fed. Cir. 1997). Further the features removed from the independent claims have been restored in dependant claims such as for example new claim 42. The amendment to the claim language does not overcome the obvious type double patenting rejection.

2. Applicant's arguments with respect to the art rejections have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-10, 30-31, 34-37, 39-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,523,124 in view of Sakai et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims merely remove limitations of the allowed claims. The claims of PN 6,523,124 is silent as to the newly external device is providing power. Sakai et al teaches the claimed external device providing power (AC adapter). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the claimed providing power because this would have prevented power depletion with power saving disabled. See also *In re Emert* No. 96-1559 U.S. CAFC 44 U.S.P.Q.2D (BNA) 1149.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10, 30-31, 34-35, 42-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 8 and 43 recites the limitation "the signal" after the section that includes "a signal" was deleted. There is insufficient antecedent basis for this limitation in the claim.

Claim 35 is dependant upon cancelled base claim 32.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai et al PN 5,613,135 in view of Townsley et al PN 5,557,738.

In regards to claims 1, 43-44, 51: Sakai et al teaches a method of operating a portable computing device (portable computer), the method comprising: detecting that an external device (AC adapter) is actively connected and providing power (Column 7 lines 62 to Column 8 line 19) to the portable computing device; and responsive to said detecting, suspending execution (power save mode is invalidated) of at least a portion of a program (power save mode) that would otherwise reduce power consumption of the portable computing device. Sakai does not expressly teach that the power save mode would reduce power consumption of the portable device after a given duration of inactivity. Sakai does teach that the power save mode includes a suspend mode. Although the examiner does not know of any suspend mode that does not monitor a given duration of inactivity to start power reduction, Sakai does not expressly state this is how the power save mode functions. Therefore for the sake of argument Townsley et al is cited which does expressly teach a power save mode that reduces power consumption of a

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computing device after a given duration of inactivity (Figure 2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include Townsley's sleep state in the power save mode of Sakai et al because this would have allowed for full power operation when the user is active.

In regards to claim 2: Townsley et al teaches the duration of inactivity is a time out feature.

In regards to claim 5: Sakai et al does not expressly teach the selective control being in response to coupling of the external device. Sakai et al does however teaches selective control of the power save mode (hot key etc). It would have been obvious to include selective control in the coupling function because this would have allowed for greater user power control.

In regards to claim 6: Sakai et al teaches invalidating of the power down mode.

In regards to claim 7: Sakai et al teaches a measurement of the voltage level (V) (Figure 21 into 74).

In regards to claim 8: Sakai et al teaches the adapter is a plug in adapter. Sakai et al does not teach the form of the plug. Official notice is taken that plugs that include Pins (called male as opposed to female) are very well known. It would have been obvious to include a plug with a pin/pins because this is a standard/common form of plug.

In regards to claims 10 and 47: Sakai et al teaches displaying information including such items as power mode, percent power of the battery etc. Sakai et al does not expressly teach that the displayed information can include such items as a world clock, digital images from a digital camera, and network data. It would have been obvious to allow displaying of any images accessed because this would have prevented limiting the functionality of the system.

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In regards to claims 34 and 45-46: Sakai et al teaches displaying at maximum illumination when not in power save mode.

In regards to claim 50: Sakai teaches decreasing brightness in power save mode. Sakai also teaches turning of non-essential hardware in power save mode. Sakai does not expressly teach the portable computer having a backlight. Official notice is taken that back lights are common in displays. It would have been obvious to include a backlight because this would have decreased glare.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai et al PN 5,613,135 in view of Townsley et al PN 5,557,738 as applied to claim 2 above, and further in view of "Two-Way Power Line Communication" by Ed Nisley herein after Nisley.

In regards to claims 3, 42: Sakai teaches the activation/deactivation of sleep mode as described above. Sakai et al does not teach transmitting one or more communications from the portable computing device using the external device when the external device is actively connected to the computing device. Nisley teaches two way communications over the power line. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide communications from the portable computing device over the AC lines because this would have prevented the need to also connect a network cable as well as an AC input.

In regards to claim 4: Sakai et al teaches the adapter is a plug in adapter. Sakai et al does not teach the form of the plug. Official notice is taken that plugs that include Pins (called male

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as opposed to female) are very well known. It would have been obvious to include a plug with a pin/pins because this is a standard/common form of plug.

Allowable Subject Matter

10. Claims 36, 37 and 39 are allowable over the prior art.
11. Claims 9, 30 and 31 are would be allowable if rewritten to overcome the double patenting rejection (can be done by terminal disclaimer) and rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 571 272 3639. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rehana Perveen can be reached on 571-272-3676. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRM
September 15, 2005



PAUL R. MYERS
PRIMARY EXAMINER